

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROLAND BISCHOFF, HELMUT DAUDEL,  
GUENTER FLECKENSTEIN and HERMANN HIERETH

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Appeal No. 2001-2454  
Application No. 09/267,355

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ON BRIEF

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Before ABRAMS, FRANKFORT, and McQUADE, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-20, which are all of the claims pending in this application.<sup>1</sup>

We REVERSE AND ENTER A NEW REJECTION UNDER 37 CFR 1.196(b)

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<sup>1</sup>Claim 1 was amended after the final rejection.

### BACKGROUND

The appellants' invention relates to an exhaust gas turbocharger. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the substitute appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Faletti <u>et al.</u> (Faletti)	5,813,231	Sep. 29, 1998
Daudel <u>et al.</u> (Daudel)	6,020,652	Feb. 1, 2000
		(filed Sep. 28, 1998)

Claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 1-9 and 18-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Faletti.

Claims 1, 10-13 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Faletti.

Claims 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Faletti in view of Daudel.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 14) and the final rejection (Paper No. 9) for the examiner's complete

reasoning in support of the rejections, and to the Brief (Paper No. 12) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

#### *The Examiner's Rejection Under Section 112*

On pages 3 and 4 of the final rejection, the examiner has rejected claims 1-20 as being indefinite under the second paragraph of Section 112 on three grounds. The first of these is that the phrase "subjectable to a comparison" in claim 1 is vague. However, these words do not appear in the version of claim 1 that is before us, and thus can form no basis for this rejection. The second indefiniteness issue raised by the examiner is that in claim 6 "comparison element . . . compare for comparing" is "poorly worded." This language is not present in claim 6 and therefore, again, there is no basis for this portion of the rejection. The final issue raised by the examiner here is that "there appears to be no substantial difference between the second and third paragraphs" in claim 18. We do not agree. The second paragraph states that a manual braking signal is supplied in lieu of the automatic braking controller, and the third paragraph that a selective change-over between the automatic braking controller and the manual signal

is provided. These are two different steps and, in our view, do not give rise to indefiniteness.

The rejection under 35 U.S.C. § 112, second paragraph, is not sustained.

*New Rejection Entered By The Board*

Pursuant to our authority under 37 CFR 1.196(b), we enter the following new rejection:

Claims 1-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. It is against this backdrop that we have evaluated certain of the language in the two independent claims, and found it to be indefinite.

Independent apparatus claim 1 recites a turbine which is adjustable via an automatic turbine controller during the “firing” (running) mode of engine operation and

via an engine braking system including an automatic braking controller when the turbine is to be used as a braking device. According to the claim there is a first change-over element to provide a change-over between the automatic turbine controller and the engine braking system, and a second change-over element operative to provide a change-over between the automatic brake controller and “the brake operating device” (emphasis added). However, there is no antecedent for this element, and thus one is at a loss to determine what it is or what is its relationship to the other components of the invention. Reference to the specification does not supply answers to these questions. This matter in and of itself renders claim 1 indefinite, and along with it claims 2-17, which depend from claim 1.

Immediately thereafter claim 1 states “whereby a manual braking signal is generatable in a manually adjustable brake operating device and is suppliable to the engine braking system, and the manual braking signal is compared with a rotational-speed-dependent braking limit value.” The “manually adjustable brake operating device” is not more specifically described in the claim, and therefore the above-quoted language appears to be broad enough to read on any manually adjustable braking device, including the driver’s foot-operated service brakes that normally are present in every vehicle of the type to which this invention is directed. The problem with this recitation resides in the fact that the specification doesn’t support an interpretation of the claims that is this broad, and therefore the claims do not describe the invention with

a reasonable degree of precision and particularity and the metes and bounds of the claims would not be determinable to one of ordinary skill in the art.

According to the specification, the invention includes a manual adjustable brake operating device that provides a manual braking signal “as an alternative to the automatic braking controller” (page 4). The manual brake operating device is described on page 5 as means “such as a steering column hand brake lever,” which is operated by the driver (see page 9, line 23). Considering this in the context of the objectives and operation of the appellants’ invention provided in the specification, as well as the fact that the foot-operated service brake is not mentioned in the explanation of the invention in the specification, the invention would appear not to encompass a signal from any manual braking device, but only from a manual device other than the usual foot-operated service brakes. This conclusion finds support in the Appeal Brief, where the manual braking signal is described as being “generated by a manual intervention” “on demand by the driver” (page 5). Credence also is lent to this conclusion by considering that the invention calls for the manual braking signal to be compared to a maximum acceptable braking input to the turbine to prevent damage thereto, which would not seem to be necessary or feasible if the signal were generated as a result of the application of the service brakes.

We are mindful that the appellant is free to claim his invention in broad terms, and that he is entitled to the broadest reasonable interpretation of the claim language.

However, because a patentee has the right to exclude others from making, using and selling the invention covered by the patent, the public must be apprised of exactly what the patent covers, so that those who would approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. It is to this that the second paragraph of 35 U.S.C. § 112 is directed. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). However, for the reasons set forth above, it is our view that the boundaries of claim 1 cannot be determined by one of ordinary skill in the art.

In summary, we find claim 1 to be indefinite because there is no antecedent basis for “the brake operating device” (lines 14 and 15), and because the interpretation to be accorded to “a manual braking signal . . . generatable in a manually adjustable brake operating device,” that is, the source of the manual braking signal, is not clear. The indefiniteness of claim 1 is inherited by claims 2-17, which depend therefrom.

Method claim 18 recites the steps of “supplying . . . a manual braking signal to the engine braking system,” providing a selective change-over between the automatic braking controller and “a brake operating device which supplies the manual braking signal,” and comparing the manual braking signal with a rotational speed dependent braking limit value. The reasoning expressed above regarding the manual braking device and signal which formed the basis for our conclusion that claim 1 is indefinite

also is applicable here, and thus claims 18-20 are indefinite on this ground.

*The Examiner's Rejections*

When no definite meaning can be ascribed to certain terms in a claim, the subject matter does not become unpatentable, but rather the claim becomes indefinite. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since it is clear to us that considerable speculation and assumptions are necessary to determine the metes and bounds of what is being claimed, and since rejections cannot be based upon speculation and assumptions, we are constrained to reverse all three of the examiner's rejection s that are based upon prior art. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). We hasten to point out, however, that the actions we have taken should not be construed as an indication that the claimed subject matter would not have been unpatentable in view of the prior art cited against the claims. We have not addressed this issue, for to do so would require on our part the very speculation which formed the basis of our rejection under Section 112.

Because of the indefiniteness of the claims discussed above in the newly entered rejection under the second paragraph of Section 112, the propriety of the rejections based upon the prior art cannot be evaluated. Therefore, as explained in the preceding paragraph, none of the examiner's rejections based upon prior art are sustained.

CONCLUSION



The examiner's rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph, is not sustained.

The examiner's rejection of claims 1-9 and 18-20 as being anticipated by Faletti is not sustained.

The examiner's rejection of claims 1, 10-13 and 17 as being unpatentable over Faletti is not sustained.

The examiner's rejection of claims 14-16 as being unpatentable over Faletti in view of Daudel is not sustained.

Pursuant to 37 CFR 1.196(b), claims 1-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options

with respect to the new ground of rejection to avoid termination of proceedings

(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 196(b)

NEAL E. ABRAMS  
Administrative Patent Judge

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) BOARD OF PATENT

CHARLES E. FRANKFORT  
Administrative Patent Judge

) APPEALS  
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JOHN P. McQUADE  
Administrative Patent Judge

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